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BOARD
INTERFERENCE

DEPARTMENT OF COMMERCE
UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant: CHING-WU CHU §
Serial No.: 300,063 §
Filed: January 23, 1989 § Group Art Unit: 115
For: HIGH TRANSITION TEMPERATURE §
SUPERCONDUCTING COMPOSITIONS §
Examiner: Dennis Albrecht §

SUPPLEMENTAL COMMUNICATION TO THE
PRELIMINARY AMENDMENTS OF DECEMBER 1 AND 11, 1989

Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Via FAX -- 703/557-9564

Dear Sir:

Supplementing the remarks contained in the Preliminary Amendments filed on December 1, 1989 and December 11, 1989, are the following comments. These are offered in view of certain comments made by the Examiner respecting the contents of the Preliminary Amendments.

Applicant's request that the Examiner act upon the merits of all claims now pending before declaring any interference is in accordance with the policy requirements set forth in M.P.E.P. § 2305.01. That policy is stated as follows:

"At the same time that the claims are suggested an action is made on each of the applications that are up for action by the examiner, whether they be new or amended cases. In this way possible motions under 37 CFR 1.633 (c) and (d) may be forestalled. That is, the action on the new or amended case may bring to light patentable claims that should be included as corresponding to the count of, or as forming the basis for an additional count of the interference, and, on the other hand, the rejection of unpatentable claims will serve to indicate to the opposing parties the position of the examiner with respect to such claims."

Applicant believes that an action on the merits will
"bring to light patentable claims that should be included
... as forming the basis for an additional count"

As M.P.E.P. § 2305 states:

"The question of what claim or claims to suggest in the interfering application is one of great importance, and failure to suggest such claims as will define clearly the matter in issue leads to confusion and to prolongation of the contest.

Before deciding what claim or claims to suggest to an applicant, the examiner should decide what the count or counts of the prospective interference will be, keeping in mind that the count must be patentable over the prior art and define the parties' common invention (see M.P.E.P. § 2309 regarding the formation of counts). The claim suggested to the applicant need not be identical to the prospective count, but rather should be the broadest claim within the scope of the prospective count which the applicant's disclosure will support, and which is otherwise patentable to the applicant."

The criticality of formulating a proper count is noted at
M.P.E.P. § 2301.02 as follows:

"A 'count' defines interfering subject matter. An interference may have two counts only if the second count defines a 'separate patentable invention' from the first count. The reason the second count must define a separate patentable invention is to permit the PTO to lawfully issue separate patents to different parties in an interference when a single party does not prevail as to all counts. A 'separate patentable invention' is defined in 37 CFR § 1.601(n):

Invention (A) is a "separate patentable invention' with respect to invention (B) when invention (A) is new (35 U.S.C. 102) and unobvious (35 U.S.C. 103) in view of invention (B) assuming invention (B) is prior art with respect to invention (A).

The principles which must be kept in mind in formulating a count are identified at M.P.E.P. § 2309.01:

"In formulating the count or counts, the examiner must decide two interrelated questions: (1) how many counts will there be, and (2) what will the scope of each count be. The following principles should be kept in mind.

1. Each count must be drawn to a separate patentable invention, that is to say, the invention defined in each count must not be the same as, or obvious over, the invention defined in any other count. However, a count may properly be included if it is unobvious over another count, even though the reverse might not be true. For example, a count to a species and a count to a genus might properly both be included in the interference if the species is patentable over the genus, even though the genus might not be patentable, given the species

2. A count should normally be sufficiently broad as to encompass the broadest corresponding patentable claim of each of the parties

3. A count may not be so broad as to be unpatentable over the prior art"

During the telephone conversation with the Examiner following his receipt of the two Preliminary Amendments, he expressed doubt about the patentability of the broader claims urged by applicant as the appropriate basis for forming a count for a proposed interference. This is why the Examiner should first act on the merits of all pending claims as required by M.P.E.P. § 2305.01. Further, as the Examiner is aware:

"... The 'count' ... is merely the vehicle for contesting priority which, in the opinion of the Commissioner, effectively circumscribes the interfering subject matter, thereby determining what evidence will be regarded as relevant on the issue of priority. The 'count,' as distinguished from a party's 'claim,' need not be patentable to either party in the sense of being fully supported by either party's disclosure"

Squires v. Corbett, 194 U.S.P.Q. 513, 519 (C.C.P.A. 1977)

If the Examiner's doubts about the patentability of the broader claims are based upon prior art, then he should act on the merits and issue an action letter identifying the prior art and his rationale for the rejection. If the Examiner's doubts are based upon 35 U.S.C. § 112 support, it should be evident from Squires that such concerns are inappropriate relative to a "count" as opposed to claims of a party. If the Examiner's doubts relate to a 35 U.S.C. § 112 question of overbreadth, then the Examiner is requested to consider Case v. CPC International, Inc., 221 U.S.P.Q. 196, 199 (Fed. Cir. 1984), cert. denied, 105 S.Ct. 223, which states:

"Dr. Case also asserts that the phantom counts are 'so broad as to fail to particularly point out and claim the invention in issue, and the "phantom" counts are thus unpatentable under 35 U.S.C. 112.'

[3] Case confuses 'claims' and 'counts' throughout his argument but never is wider of the mark than here. The counts are not claims to an invention by either party. The purpose of the count is to determine what evidence is relevant to the issue of priority. Squires v. Corbett, 560 F.2d at 433, 194 U.S.P.Q. at 518-19, 35 U.S.C. § 112, second paragraph relates only to actual claims.

The Examiner is further requested to consider Hsing v. Myers, 2 U.S.P.Q. 2d 1861, 1862, n.1 (Bd. Pat. Int. 1986) which states:

"... The count of an interference is merely the vehicle for contesting priority and need not be patentable under 35 U.S.C. 112 to either party. In re Kroekel, _____ F.2d _____, 231 USPQ 640 (Fed. Cir. 1986); Case v CPC International, Inc., 730 F.2d 745, 221 USPQ 196 (Fed. Cir. 1984), cert. denied, 105 S.Ct. 223, 224 USPQ 736 (1984); Squires v. Corbett, 560 F.2d 424, 194 USPQ 513 (CCPA 1977); Wiesner v. Weigert, 666 F.2d 582, 212 USPQ 721 (CCPA 1981) and Hedgewick v. Akers, 497 F.2d 905, 182 USPQ 167, note 6 (CCPA 1974). See §§ 1.601(f), 1.603 and 1.606."

For reasons set forth in the remarks of the Preliminary Amendment filed December 1, 1989, Applicant believes broader claims 19, 22, 23, 25 and/or 26 are each patentable over the prior art. Such "doubts" as the Examiner may have about the patentability of such broader claims to Applicant under the written support or particularity requirements of 35 U.S.C. § 112 are not relevant "doubts" vis a vis the use of such broader claims as the basis for an interference count.

Further, since the Board of Patent Appeals and Interferences now decides the issue of "patentability of the invention", see 37 C.F.R. § 1.655(a)(3), the Examiner should resolve his doubts in favor of patentability and utilize the broader claims as forming the basis for a count of the interference. If such broader claims are of "doubtful" patentability to Applicant, the opposing party in the interference may file a motion under 37 C.F.R. § 1.633(a) and after full discussion of the issue by Responses and Replies under 37 C.F.R. § 1.638, the Examiner-in-Chief (EIC) will be able to decide the matter. Moreover, the decision of the EIC will then be subject to review by the Board of Patent Appeals and Interferences and thereafter, if necessary, by the Court of Appeals for the Federal Circuit or other reviewing Court. These reviews should provide more than enough safeguards for the Examiner's action if it becomes clear the claims are not patentable to someone under 35 U.S.C. § 103.

Accordingly, before declaring an interference, the Examiner should either resolve his doubt now during ex parte prosecution so that Applicant may appeal and have

the matter reviewed if the Examiner resolves his doubt against patentability. If there is reason to proceed with a declaration of interference before such "doubt" may be finally resolved by ex parte procedures, then for purposes of declaring such interference that "doubt" can safely be resolved in favor of declaring the interference on the broad count. Resolution of such doubt in favor of a broad count will enable the parties to fully discuss the issue in preliminary motions placing into action the self-correcting review procedures of the Examiner-in-Chief's and the Board's seriatim authority to decide the issue of "patentability of the invention."

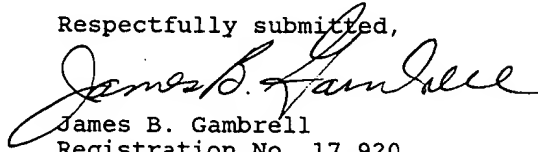
If the Examiner is still in doubt or believes the practice of count formation to be obscure or confused after reflecting on it, it is submitted that the Examiner should follow the stricture of M.P.E.P. § 2309.05:

"The examiner should consult with one of the examiners-in-chief in any case of doubt or where the practice appears to be obscure or confused. In view of their specialized experience they may be able to suggest a course of action which will avoid considerable difficulty in the future treatment of the case."

If still in doubt, the Examiner is requested to confer with Ronald Smith, author of the decision in Heymes v. Takaya, 6 U.S.P.Q.2d 1448 (Bd. Pat. Int. 1988) and the Examiner-in-Chief in Interference No. 101,981 which the Examiner previously set up to cover "123" superconductors.

Counsel apologizes for revisiting the question of the counts in the new interference proposed by the Examiner, but it is so important to set up the correct interference that it seems imminently worthwhile.

Respectfully submitted,


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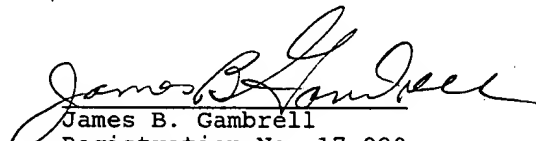
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Date: December 27, 1989

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below and that a copy is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on this the 27th day of December, 1989.

Date: December 27, 1989


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